<center>**REMARKS**</center>

Claims 1, 4, 9, 12, 15, 16, 17, 26, 27, 30, 35, 36 and 39 have been amended. No claims have been added or canceled. Therefore, claims 1-2, 4-10, 12-31, 33-37 and 39 remain pending in the application. Reconsideration is respectfully requested in light of the following remarks.

Objection to the Specification:

Claim 15

The Examiner objects to the specification for allegedly failing to provide proper antecedent basis for the limitations of claim 15. Applicant asserts this rejection is improper because the specification of the present application clearly provides support for the claimed limitations, as described in more detail below. For instance, in regard to the "means for storing a set of multiple identifiers..." limitation of claim 15, Applicant's specification clearly describes a payment device 100 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 1, items 100, 110 and 112; page 7, lines 1-2; page 10, lines 19-28). In another example, regarding the "means for selecting..." limitation of Applicant's claim, Applicant's specification clearly describes that the payment device (e.g., payment device 100) is configured to perform such a selection (*see e.g.,* page 12, lines 29-34). In yet another example, in regard to the "means for creating..." limitation of Applicant's claimed invention, Applicant's specification clearly describes that the payment device (e.g., payment device 100) is configured to perform such creation (*see e.g.,* page 12, line 36 – page 13, line 3). In light of the above, Applicant notes that the specification of the present application provides clear support for each of the aforesaid limitations. Accordingly, Applicant respectfully requests removal of this objection.

Claim 39

The Examiner objects to the specification for allegedly failing to provide proper antecedent basis for the limitations of claim 39. Applicant asserts this rejection is improper because the specification of the present application clearly provides support for the claimed limitations, as described in more detail below. For instance, in regard to the "means for storing a plurality of customer account records..." limitation, Applicant notes the specification clearly describes a credit company computer 330 and customer account database 332 configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, item 330, 332, 336; page 9, lines 20-25). In regard to the "means for storing a mapping..." limitation, Applicant notes that the specification clearly describes the credit company computer 330 and customer account 332 as being configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330, 332, 334; page 9, lines 20-25; page 10, lines 30-34). In regard to the "means for accessing an identifier..." limitation, Applicant notes that the specification clearly describes the credit company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330; page 14, lines 10-15). In yet another example, regarding the "means for accessing a digital signature..." limitation, Applicant's note that the specification clearly describes the credit card company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, item 330; page 14, lines 10-15 and 26-32). In regard to the "means for updating a customer account record..." limitation, Applicant's note the specification clearly describes that credit card company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330, 332; page 14, lines 34-37). In light of the above, Applicant notes that the specification of the present application provides clear support for each of the aforesaid limitations. Accordingly, Applicant respectfully requests removal of this objection.

Section 112, Second Paragraph, Rejection:

The Examiner rejected claims 14, 15 and 39 under 35 U.S.C. § 112, second paragraph, as allegedly indefinite. Applicant traverses the rejection for at least the following reasons.

Claim 14

In regard to claim 14, the Examiner asserts that the limitations of claim 14 would be unclear to one of ordinary skill in the art. Applicant respectfully disagrees. The metes and bounds of claim 14 are clearly set forth by the claim limitations. For example, claim 14 recites "prevent[ing] rapid readout of the identifiers" <u>in a specific manner</u>, namely by "limiting the number of transactions performed during a given period of time." Nothing about "limiting the number of transactions performed during a given period of time," much less doing so to "prevent rapid readout of the identifiers" would be unclear to one of ordinary skill in the art. **The Examiner failed to provide any response at all to this argument in the Office Action of July 27, 2009.**

Furthermore, the Examiner provides <u>no substantive reasoning</u> as to why the aforesaid limitations would be unclear to one of ordinary skill in the art. Instead, the Examiner questions "how" the "apparatus" would perform the claimed limitation. Applicant respectfully reminds the Examiner that claim 14 is a method claim, not an apparatus claim. Furthermore, claim 14 specifically sets forth "how" the manner in which "prevent[ing] rapid readout of the identifiers" is performed, namely by "limiting the number of transactions performed during a given period of time." One of ordinary skill in the art would clearly understand the plain language of Applicant's claim. Furthermore, as described above, the plain language of Applicant's claim limitations clearly sets forth the metes and bounds of claim 14. Applicant reminds the Examiner that "Breadth of a claim is not to be equated with indefiniteness." M.P.E.P. § 2173.04; *In re Miller*, 441 F.2d 689, 169 USPQ 597 (CCPA 1971). **The Examiner failed to provide any response at all to this argument in the Office Action of July 27, 2009.** For at least

these reasons, Applicant asserts the Examiner's rejection of claim 14 is improper and removal thereof is respectfully requested.

Claim 15

In regard to claim 15, Applicant asserts that the specification provides appropriate structure for each distinct function specified by claim 15. For instance, in regard to the "means for storing a set of multiple identifiers..." limitation of claim 15, Applicant's specification clearly describes a payment device 100 is configured to perform this feature of Applicant's claimed invention (see e.g., Figure 1, items 100, 110 and 112; page 7, lines 1-2; page 10, lines 19-28). In another example, regarding the "means for selecting..." limitation of Applicant's claim, Applicant's specification clearly describes that the payment device (e.g., payment device 100) is configured to perform such a selection (see e.g., page 12, lines 29-34). In yet another example, in regard to the "means for creating..." limitation of Applicant's claimed invention, Applicant's specification clearly describes that the payment device (e.g., payment device 100) is configured to perform such creation (see e.g., page 12, line 36 – page 13, line 3).

Applicant asserts the § 112 rejection of claim 15 is clearly improper because each function of claim 15 is clearly linked to corresponding structure of the specification. Given the very clear nature of the specification in regard to the functions of claim 15 (as demonstrated above), no one of ordinary skill in the art would encounter difficulty in recognizing the respective structure corresponding to each element of claim 15. For at least these reasons, Applicant asserts the § 112 rejection of claim 15 is improper and removal thereof is respectfully requested.

Claim 39

In regard to claim 39, Applicant asserts that the specification provides appropriate structure for each distinct function specified by claim 39. For instance, in regard to the "means for storing a plurality of customer account records..." limitation, Applicant notes

the specification clearly describes a credit company computer 330 and customer account database 332 configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, item 330, 332, 336; page 9, lines 20-25). In regard to the "means for storing a mapping..." limitation, Applicant notes that the specification clearly describes the credit company computer 330 and customer account 332 as being configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330, 332, 334; page 9, lines 20-25; page 10, lines 30-34). In regard to the "means for accessing an identifier..." limitation, Applicant notes that the specification clearly describes the credit company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330; page 14, lines 10-15). In yet another example, regarding the "means for accessing a digital signature..." limitation, Applicant notes that the specification clearly describes the credit card company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, item 330; page 14, lines 10-15 and 26-32). In regard to the "means for updating a customer account record..." limitation, Applicant notes the specification clearly describes that credit card company computer 330 is configured to perform this feature of Applicant's claimed invention (*see e.g.,* Figure 3, items 330, 332; page 14, lines 34-37).

Applicant asserts the § 112 rejection of claim 39 is clearly improper because each function of claim 39 is clearly linked to corresponding structure of the specification. Given the very clear nature of the specification in regard to the functions of claim 39 (as demonstrated above), no one of ordinary skill in the art would encounter difficulty in recognizing the respective structure corresponding to each element of claim 39. For at least these reasons, Applicant asserts the § 112 rejection of claim 39 is improper and removal thereof is respectfully requested.

Section 103(a) Rejections:

The Office Action rejected claims 1, 2, 5, 7-10, 13, 26, 28 and 29 under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (U.S. Publication 2006/0218098) (hereinafter "Walker") in view of Pitroda (U.S. Publication 2005/0247777), claims 4, 12

and 27 as being unpatentable over Walker in view of Pitroda and further in view of Carlisle et al. (U.S. Patent 5,649,118) (hereinafter "Carlisle"), claim 6 as being unpatentable over Walker in view of Pitroda and further in view of Palomo et al. (U.S. Publication 2003/0120527) (hereinafter "Palomo"), claims 17-23 and 25 as being unpatentable over Flitcroft in view of Carlisle, and claim 24 as being unpatentable over Flitcroft in view of Carlisle and further in view of Bahar (U.S. Publication 2005/0001027). Applicant traverses these rejections for at least the following reasons.

Claim 1

In regard to claim 1, the cited art fails to teach or suggest wherein the apparatus is operable to i) receive bill details for a given transaction of said plurality of transactions from the terminal through the communications facility, wherein the bill details specify an amount to be paid, ii) **generate a transaction record that includes the bill details and a particular identifier selected by the processor from said set of multiple identifiers**, iii) **digitally sign the transaction record with a digital signature**, the digitally signed transaction record including the bill details and the particular identifier; and iv) **transmit the digitally signed transaction record to the terminal** through the communications facility.

The Examiner acknowledges that Walker fails to teach the receipt of bill details, the generation of a transaction record, and the transmitting of the transaction record according to the specific limitations of claim 1 (*see e.g.,* Office Action of July 27, 2009, page 11). The Examiner relies on paragraphs [0089] and [0100] of Pitroda, none of which (even when considered in combination with Walker) teach or suggest the specific limitations of Applicant's claim. In paragraph [0100], Pitroda discloses the following:

> If the sales person is satisfied with the signature comparison, the sales
> person completes the transaction, and the CIU <u>transmits completed details</u>
> of the sales transaction to the point of sales computer, the UET card, and
> the American Express service. <u>Those details include the date of the</u>
> <u>transaction, the amount, the name of the retail store or service (for the</u>
> <u>UET card and the American Express service records), the name of the</u>

customer (for the American Express and point of sales computers), etc.
(emphasis added)

The "completed details" described by the cited art (on which the Examiner presumably relies to teach Applicant's claimed "transaction record") do not include both bill details (that specify an amount to be paid) and a selected identifier associated with a customer account from a set of multiple identifiers associated with that customer account. Furthermore, the "completed details" are not digitally signed. Pitroda does describe an "American Express account number" that is collected from his UET card (Pitroda, paragraph [0099]); however, this account number has nothing to do with a digitally signed transaction record, nor is such account number transmitted as part of a digital signed transaction record to Pitroda's CIU (on which the Examiner presumably relies to teach the claimed "terminal," see e.g., Pitroda, paragraph [0099]). The "completed details" cited by the Examiner (see e.g., Office Action of July 27, 2009, page 12) do not include an account identifier selected from multiple account identifiers for the same customer account. **In fact, Pitroda teaches that the "American Express account number" and the "completed details" are handled separately (see e.g., Pitroda, paragraphs [0099]-[0100]), not together as part of the _same_ digitally signed transaction record.** The "completed details" of the transaction are sent after "the sales person is satisfied with the signature comparison," well after the "American Express account number" is sent to the "American Express credit service" (see e.g., Pitroda, paragraph [0099]-[0100]). In Pitroda's system (even when considered in light of Walker), account numbers and transaction details are handled separately, not together as part of a digitally signed transaction record. In light of the above, the cited art clearly fails to teach the specific limitations of Applicant's claim.

Furthermore, Applicant asserts the Examiner has failed to provide a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Walker and Pitroda. The Examiner asserts that such a combination would have been obvious "in order to facilitate transaction (sic) and ensure record keeping and tracking." However, "facilitate[ing] transaction[s]" and "ensur[ing] record keeping and tracking" are already fulfilled by the teachings of Walker. In regard

to facilitated transactions, Walker clearly teaches a "device for facilitating financial account transactions" (Walker, Abstract). In regard to ensuring record keeping and tracking, Walker clearly teaches a "credit card transaction database 413" (Walker, Figure 4). One of ordinary skill in the art clearly would <u>not</u> have been motivated to combine the teachings of Pitroda with the teachings of Walker for "facilitate[ing] transaction[s]" and "ensur[ing] record keeping and tracking" because Walker already provides mechanisms for "facilitate[ing] transaction[s]" and "ensur[ing] record keeping and tracking." Accordingly, the Examiner has merely provided a reason to use the teachings of Walker alone, not a reason to combine the teachings of Pitroda (or any other reference) with Walker. As the Examiner is certainly aware, "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, there *must* be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness'" (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. **Since the Examiner has not presented such reasoning, the Examiner's rejection is improper.**

Thus, for at least the reasons presented above, the rejection of claim 1 is unsupported by the teachings of cited art and removal thereof is respectfully requested. Similar remarks apply to claims 9 and 26.

Claim 17

In regard to claim 17, the cited art fails to teach or suggest receiving from a terminal, a digitally signed transaction record comprising **a digital signature generated on the portable transaction device, wherein the digitally signed transaction record comprises bill details provided by the terminal to the portable transaction device prior to the creation of the digital signature, wherein the bill details specify an amount to be paid for a transaction corresponding to the transaction record, wherein the digitally signed transaction record further comprises a particular identifier selected by the portable transaction prior to the creation of the digital**

signature, and decrypting and validating the digital signature of the digitally signed transaction record with the public key.

Neither Flitcroft nor Carlisle (considered singly or in combination) teach or suggest a digitally signed transaction record generated on a portable transaction device, according to the specific limitations of claim 1. More specifically, Filtcrot teaches a credit card system that has an added feature of providing additional limited-use credit card numbers and/or cards (Flitcroft, Abstract); however nowhere does Flitcroft teach a digitally signed transaction record (that includes both bill details and a selected identifier) generated on a portable transaction device, much less validating the digital signature of such a digitally signed transaction record. Carlisle fails to overcome these deficiencies. For instance, Carlisle teaches a smart card with a plurality of accounts stored thereon (Carlisle, Abstract); however, nothing about Carlisle's system (even when considered in light of Flitcroft) pertains to a digitally signed transaction record (that includes both bill details and a selected identifier) generated on a portable transaction device, much less validating the digital signature of such a digitally signed transaction record. The cited art simply does not teach the aforesaid limitations of Applicant's claim.

Furthermore, Applicant asserts the Examiner has failed to provide a proper reason as to why one of ordinary skill in the art would have been motivated to combine the teachings of Flitcroft and Carlisle. The Examiner asserts that such a combination would have been obvious "ensure adequate security." However, "ensuring adequate security" is already fulfilled by the teachings of Flitcroft. For instance, Filtcrot teaches:

> It is also envisaged that in certain situations credit cards can be provided to people who do not have an account with any credit card company. This latter feature is described in more detail below. Various other features may be provided in the above situations which will further improve the security of credit card transactions. (Flitcroft, column 7, lines 31-36).

One of ordinary skill in the art clearly would <u>not</u> have been motivated to combine the teachings of Carlisle with the teachings of Flitcroft to "ensure adequate security" because Flitcroft already provides mechanisms for "ensure[ing] adequate security," as

demonstrated above. Accordingly, the Examiner has merely provided a reason to use the teachings of Flitcroft alone, not a reason to combine the teachings of Carlisle (or any other reference) with Flitcroft. As the Examiner is certainly aware, "'[R]ejections on obviousness cannot be sustained by mere conclusory statements; instead, <u>there *must* be some articulated reasoning with some rational underpinning</u> to support the legal conclusion of obviousness'" (emphasis added). *KSR v. Teleflex*, 550 U.S. 398 (2007), 82 USPQ2d 1385, 1396. **Since the Examiner has not presented such reasoning, the Examiner's rejection is improper.**

Claim 15

Applicant notes that the Examiner has not state a *prima facie* rejection of claim 15. More specifically, the Examiner groups the § 103 rejection of claim 15 with the rejection of claim 17 (*see e.g.,* Office Action of July 27, 2009; page 17, last line); however, there are clear differences between the limitations of claim 15 and the limitations of claim 17. For instance, claim 15 recites "means for selecting, for each of a plurality of transactions involving the same customer account, a different identifier from said set of multiple identifiers for use with the respective transaction" among other limitations. Claim 17 does not include such limitation. Accordingly, the Examiner has failed to state a *prima facie* rejection of claim 15.

Section 102(e) Rejection:

The Office Action rejected claims 16, 30, 31, 33-35, 36, 37 and 39 under 35 U.S.C. § 102(e) as being anticipated by Flitcroft et al. (U.S. Patent 7,136,835) (hereinafter "Flitcroft"). Applicant traverses the rejection for at least the following reasons.

Claim 30

In regard to claim 30, Flitcroft fails to teach receiving from a terminal, a digitally signed transaction record generated by a particular portable transaction device for a transaction on a given customer account, wherein the digitally signed transaction record comprises a digital signature generated by the particular portable transaction device associated with the customer account, wherein the digitally signed transaction record includes bill details provided by the terminal to the particular portable transaction device, wherein the digitally signed transaction record further includes a particular identifier selected by the particular portable transaction device from the set of identifiers stored within that portable transaction device.

More specifically, Flitcroft teaches a credit card system that has an added feature of providing additional limited-use credit card numbers and/or cards (Flitcroft, Abstract); however nowhere does Flitcroft teach a digitally signed transaction record (that includes both bill details and a selected identifier) generated on a portable transaction device, much less verifying the digital signature of such a digitally signed transaction record. The cited art simply does not teach this feature of Applicant's claimed invention. As the Examiner is certainly aware, "[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign et al.*, Case No. 07-1565 (Fed. Cir., Oct. 20, 2008). Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim. M.P.E.P 2131; *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The identical invention must be shown in as complete detail as is contained in the claims. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Thus, for at least the reasons presented above, the rejection of claim 30 is unsupported by the teachings of cited art and removal thereof is respectfully requested. Similar remarks apply to claims 36 and 39.

Claim 16

In regard to claim 16, the Flitcroft fails to teach wherein the apparatus is operable to receive bill details for the given transaction from the terminal through the communications facility, wherein the bill details specify an amount to be paid, generate a transaction record that includes the bill details and the given identifier that is randomly or pseudo-randomly selected by the processor from said set of multiple identifiers, digitally sign the transaction record with a digital signature, the digitally signed transaction record including the bill details and the given identifier, and transmit the digitally signed transaction record to the terminal through the communications facility. More specifically, Flitcroft teaches a credit card system that has an added feature of providing additional limited-use credit card numbers and/or cards (Flitcroft, Abstract); however nowhere does Flitcroft teach a digitally signed transaction record (that includes both bill details and a selected identifier) generated on a portable transaction device, much less transmitting such a digitally signed transaction record to a terminal. The cited art simply does not teach this feature of Applicant's claimed invention. As the Examiner is certainly aware, "[U]nless a reference discloses within the four corners of the document not only all of the limitations claimed but also all of the limitations arranged or combined in the same way as recited in the claim, it cannot be said to prove prior invention of the thing claimed and, thus, cannot anticipate under 35 U.S.C. § 102." *Net MoneyIN, Inc. v. VeriSign et al.*, Case No. 07-1565 (Fed. Cir., Oct. 20, 2008).

Thus, for at least the reasons presented above, the rejection of claim 16 is unsupported by the teachings of cited art and removal thereof is respectfully requested.

In regard to the § 102 and § 103 rejections, Applicant also asserts that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejection has been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time. Applicant reserves the right to present additional arguments.

CONCLUSION

Applicant submits the application is in condition for allowance, and an early notice to that effect is respectfully requested.

If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5681-20500/RCK.

Respectfully submitted,

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